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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,891

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Bryan E. Cole

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EXAMINER

TANINGCO, MARCUS H

ART UNIT

PAPER NUMBER

2884

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,891	<b>Applicant(s)</b> COLE ET AL.	
	<b>Examiner</b> MARCUS H. TANINGCO	<b>Art Unit</b> 2884	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation “the lens array” in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. Note that a lens array is first mentioned in claim 19.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 7-9, 16, 17, and 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciesla et al. (*Ciesla*, GB 2352512).

With regards to claim 1, Ciesla discloses a radiation probe for imaging an object comprising: at least one emitter for emitting radiation, a plurality of detectors for detecting radiation and means for directing radiation emitted by the at least one emitter to the object and

Art Unit: 2884

for directing radiation reflected from the object to at least two of the plurality of detectors wherein in use, the emitted radiation is scanned across the object (Fig. 12), wherein in use the emitter and said detectors functioning together form a 1:1 proportion.

With regards to claim 2, Ciesla discloses said emitter comprises a frequency conversion member of the recited type (pg. 2).

With regards to claims 4 and 5, Ciesla discloses said at least one emitter is configured to emit pulses of radiation having a plurality of frequencies, at least one of said frequencies being in the range from 25 GHz to 100THz. (pg. 1, 3).

With regards to claim 7, Ciesla discloses said array comprises a single central emitter surrounded by the plurality of detectors (Fig. 11).

With regards to claim 8, Ciesla discloses said plurality of detectors are directed towards a point such that in use the object is located at this point (Fig. 13).

With regards to claim 9, Ciesla discloses that the central emitter directs the emitted radiation into a directed beam (Fig. 2).

With regards to claims 16 and 17, Ciesla discloses said emitter and detectors are mounted within a self contained housing module (pg. 7). Furthermore, it has been held that the recitation that an element is “capable of” performing a function is no a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

With regards to claim 19, Ciesla discloses said array further comprises a lens array to focus the irradiating radiation onto the at least one emitter and plurality of detectors (pg. 24).

Art Unit: 2884

With regards to claim 20, Ciesla discloses that the irradiating radiation is supplied by means of a number of optical fibres (pg. 4).

With regards to claim 21, Ciesla discloses a separate optical fibre supplies irradiating radiation to a single emitter/detector (Fig. 13).

With regards to claim 22, Ciesla discloses the recited lens array (pg. 4, 24)

With regards to claim 23, Ciesla discloses the array further comprises a THz transmitting array to couple in or out any THz radiation (pg. 24).

With regards to claim 24, Ciesla discloses a THz transmitting array of the recited type (pg. 4).

With regards to claim 25, Ciesla discloses signal processing means for analyzing the radiation detected by the probe array (pg. 7).

With regards to claim 26, Ciesla discloses a source of e/m radiation for irradiating the probe array (Fig. 1).

With regards to claim 27, Ciesla discloses the source provides a beam of radiation and the system further comprises a series of beam-splitters and fibre couplers, each beam-splitter being arranged to couple a proportion of the beam of radiation via a fibre coupler into an optical fibre such that in use the optical fibre irradiates the probe array (Fig. 1).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2884

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10-13, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciesla et al.

With regards to claims 10-13, Ciesla fails to teach the recited number and configuration of emitter and detectors. However, it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide an equal number of emitters and detectors, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reconfigure the arrangement taught by Ciesla, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re* Japikse, 86 USPQ 70.

With regards to claim 28, Ciesla fails to teach the recited lens array. Nevertheless, optical elements such as a lens array used to direct a portion of light is well known and is viewed as a matter of routine design choice.

Art Unit: 2884

With regards to claim 29, Ciesla discloses said array may be configured as a hand held unit. With regards to the specific configuration, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reconfigure the arrangement taught by Ciesla, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

8. Claims 3, 6, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciesla et al. in view of Arnone et al. (*Arnone*, US 2003/0178584).

With regards to claim 3, Ciesla fails to teach said emitter and detectors are photoconductive devices. Arnone teaches a THz imaging device comprising photoconductive emitter and detectors. It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ciesla with Arnone in order to provide higher penetration depths.

With regards to claim 6, Ciesla discloses all aspects of the claimed invention, but fails to teach means for raster scanning. Nevertheless, moving the emitter relative to the object or vice versa, is well known. An example is taught by Arnone [0141]. As such, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ciesla with Arnone depending upon the needs of the application.

With regards to claims 14 and 15, Arnone teaches raster scanning, but fails to teach scanning by a linear translation of a stack nor by rotation about an axis through the stack. With regards to the specific type of scan, those skilled in the art appreciate that, absent some degree of criticality, the scanning technique would have been a matter of routine design choice that would have been within the skill of a person of ordinary skill in the art depending on the needs of the

Art Unit: 2884

particular application.

### **Response to Amendments/Arguments**

9. The indicated allowability of claims 1-17 and 19-29 is withdrawn after further consideration of the Ciesla reference. In the previous Office Action mailed on 11/14/08, claim 1 was indicated as being allowable based on the thought that Ciesla failed to teach “wherein only a proportion of the total number of emitters and detectors are in use at any given time.” However, after further consideration, a 1:1 proportion is formed when the emitter and the plurality of detectors of Ciesla are used. Furthermore, Applicant should note that apparatus claims must be structurally distinguished from the prior art. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15, USPQ2d 1525, 1528, (Fed. Cir. 1990). See MPEP 2114. In other words, even if the present application used less than the total number of emitters and detectors at any given time, the structure would be indistinguishable when compared to the radiation probe of Ciesla.

### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Art Unit: 2884

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus H. Tanningco whose telephone number is (571) 272-1848.

The examiner can normally be reached on M - F 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Constantine Hannaher/  
Primary Examiner, Art Unit 2884**

**/Marcus H Tanningco/  
Examiner, Art Unit 2884**